

### **DETAILED ACTION**

This responds to Applicant's Arguments/Remarks filed 07/28/2011. Claims 1, 16, and 45 have been amended. Claims 17 and 29 stand cancelled. Claims 1-16, 18-28, and 30-47 are pending in the application.

#### ***Response to Amendments***

1. Applicant has amended Claims 16 and 45. Thus, the objections to Claims 16 and 45 for lack of antecedent basis are withdrawn.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-15, 18-27, and 31-33 are rejected under 35 U.S.C. 101 because the method of remotely configuring the gaming machine lacks a recitation of an interface, means, or instrumentality necessary for an operator to remotely configure a bonus game. Based upon consideration of all the relevant factors with respect to the claims as a whole, Claims 1-15, 18-27, and 31-33, are held to claim an abstract idea, and is therefore rejected as ineligible subject matter under 35 U.S.C. 101. The rationale for this finding is explained below:

- a. Factors weighing toward eligibility are:

- i. A recitation of a machine or transformation in particular, machine or transformation meaningfully limits the execution of the steps, the article being transformed is particular, a machine implements the

claimed steps, the article being transformed is particular, the article undergoes a change in state with an objectively different function or use;

- ii. Applies a law of nature, practically applied, meaningfully limits the execution of the steps;
- iii. More than a merely statement of a concept; describes a particular solution of the problem to be solved, implements a concept in a tangible way, performance of steps are observable and verifiable;

b. Factors weighing against eligibility are:

- i. No recitation of a machine or transformation;
- ii. Insufficient recitation of a machine or transformation
- iii. Involvement of the machine or transformation, with steps is merely nominally, insignificantly, or tangibly related to the performance of the steps, e.g., data gathering, or merely recites a field in which the method is intended to be applied
- iv. Machine is generically recited such that it covers any machine capable of performing the claimed step(s)
- v. Machine is merely an object on which the method operates
- vi. Transformation involves only a change in position or location of the article
- vi. Directed to an application of a law of nature
- vii. Would monopolize a natural force or patent a scientific fact (e.g., by claiming every mode of producing an effect of that law of nature
- viii. Applied in a merely subjective determination
- ix. Merely nominally, insignificantly, or tangentially related to the performance of the step(s)
- x. Is a mere statement of a general concept; use of the concept, as expressed in the method, would effectively grant a monopoly over the concept
- xi. Both known and unknown uses of the concept are covered, and can be performed through any existing or future-devised machinery, or even without any apparatus
- xii. States only a problem to be solved
- xiii. General concept is disembodied; mechanism by which the step(s) are implemented is subjective or imperceptible, examples of general concepts: Basic economic practices or theories, basic legal theories, mathematical concepts, mental activity, interpersonal relations or relationships, teaching concepts, human behavior, and instructing

4. Claims 1-15, 18-27, and 31-33 are rejected under 35 U.S.C. 101 because the method of remotely configuring a gaming machine is divorced from the interface, means, or instrumentality to carry out the claimed steps for an operator to remotely configure a bonus game. Factors weighing in favor of patentability are the various gaming machines which are networked to be configured. Factors weighing against patentability are the lack of recitation of an apparatus or means upon which an operator would effect the "receiving from a remote location", "selection of bonus triggering criteria", "selection of visual activities", "receiving a selection of awards", "storing the selections" and so forth from a remote location. Lacking proper machine implementation or other indication of means to accomplish the steps, the preamble of a

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method for an operator of networked gaming machines to remotely configure a bonus game is a disembodied concept as there is no machine or means in the preamble or recited in the body of the claim. Conversely, the steps may be performed manually through observation and wherein a remote operator could receive information upon which to make decisions for local implementation from both a local or remote location. Upon weighing the factors both for and against patentability, the factors against prevail. The dependent claims fail to provide a remedy with the exception of Claims 16 and 45 which disclose an operator configuration workstation to carry out the method. Appropriate attention is required. Examiner notes that Applicant has made amendments to the claims but remains unclear as to how the amendments pertain to or cure the rejection of the claims. Appropriate attention is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:
  - a. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 1-15, 18-27, and 31-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Claim 1 preamble recites for an operator of networked gaming machines to remotely configure a bonus game. Yet the body of the claim recites steps of receiving and selecting by an operator in the absolute rendering the method overly broad such that the metes and bounds of the steps are carried out cannot be definitively determined. A user of a manual, oral, or

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machine implementation of the method would not know where infringement begins and ends as the claim is presented amended. Since Applicant discloses a configuration workstation to enact the remote control of the networked system (Specification, Field of the Invention and Summary Page 1 Lines 30-34) and has previously argued that the patentable feature is that selections are made at a configuration workstation (Applicants Arguments/Remarks filed 1/15/2010 "Accordingly, Applicants submit that Gauselmann does not describe nor suggest selecting the recited elements at a configuration workstation for use by one or more gaming machines, as defined in Applicants' specification"), the claim is overly broad in that the claim is not distinctly claiming what Applicant regards as his invention. Examiner notes that Applicant has made amendments to the claims but remains unclear as to how the amendments pertain to or cure the rejection of the claims. Appropriate attention is required.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
10. Claims 1, 14-16, 34-39, and 41-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,884,173 to Gauselmann (Gauselmann) of record in view of U.S. Patent Pub. No. 2004/0219962 to Vancura (Vancura) of record.

In Reference to Claims 1, 34, 38-39, and 41-46

Gauselmann discloses a system and method for an operator of networked gaming {wagering} machines (Fig. 3 "machines" 10 with "coin slot" 16; [0020]) to remotely configure (Abstract "each of the EGMs is remotely configurable"; Fig. 4; see also [0006, 0032, 0045] wherein "All the initial settings may, instead, be directly defined via an operator's console without the operator being physically present at any EGM." [0006]) a base game (Fig. 4) on at least one of the networked gaming machines (Fig. 3) at least some of the gaming machines being of a type having a base game display area

and a bonus game display area {video display separated from the display of a base game} (Fig.1 12 14 and "display the game itself along with display 12" [0019]), the system and method comprising:

receiving from a location remote from the networked gaming machines a selection {at a configuration workstation} from a location remote from the gaming machines ("operator's console" [0006]; "operator interface terminals" 58 and 59 [0032] wherein any number of EGMs can be modified [0048] or a selected EGM used by a particular player [0052]; fig. 3 shows the "Operator interfaces 58 and 59 remotely located from the floor servers and EGMs) coupled to the gaming machines over the network (Fig. 3 wherein the configuration interface terminals 58 and 59 are networked to "EGM"s 10A, B and C through "Floor servers" 52, 54);

also at least one of a plurality of possible criteria displayed in a list on a monitor (Fig. 4 Step 62 "Display menus on EGM screen offering possible configurations" 62) resulting from a program including a rule generator ("initializes a configuration program in the EGM" [0005] including a rule generator to display lists wherein "The operator makes his selection of the various parameters offered by the menu-driven program" [0005]; see also [0026, 0038]) to thereby define a criterion related to at least one of a base {bonus} game (Gauselmann discloses "Each EGM is configurable so as to enable an operator to select any available parameter of the game, such as the type of game offered by the EGM, such as the type of game offered by the EGM ...or any other parameter." [0004]; types of games displayed are disclosed in Fig. 5, e.g., "Cops n'

"Robbers" and "Roulette" and in Fig. 6 wherein "Game X" can include types of "Other", "Free game" and "Credit Game");

receiving a selection from a location remote from the networked gaming machines {using an input device} {at the remotely located configuration workstation} at least one of a plurality of possible visual activities displayed in a list for presentation on the bonus game display area of the gaming machine to which the criterion is related ("The operator makes his selection of the various parameters offered by the menu-driven program" [0005] of Figs. 5 and 6 in which "selections made by the operator by touching portions of the screen" [0038, 0039]. The visual activities comprise games which are presented in a list ("matrix" [0039]) on the display screen as seen in Figs. 5 and 6; "Many other types of presentations are possible." [0041]);

receiving a selection from the location remote from the networked gaming machines {at the remotely located configuration workstation} at least one of a plurality of special features and {plurality of} award methods wherein each of the plurality of award methods defines a method used to determine an item of value to be awarded (Gauselmann discloses special features of the selecting the reels, paylines and multiplier values of the award in Fig. 6 and selection among "paytables" [0024, 0042]);

storing in memory the selections on the network (Fig. 4 "Upload settings to external central memory" 64, [0043]);

operating one of the gaming machines {receiving the one or more selected criteria at the gaming machine configuring it} in accordance with the stored selections including (operator sets the EGM in play mode [0044]);

receiving player data that includes at least player demographic data (player PIN data and any other information [0023] and monitored player activity (floor servers perform automatic accounting and other data collection on a periodic basis [0029], the floor controllers networked to the EGMs and operator's console as in Fig. 3); and awarding according to a plurality of award methods a plurality of items of value earned (Gauselmann discloses menus for selecting paytables [0021] as award methods as well as in Fig. 6 configuration options including "20X", "10X", "5X", "1X" and "xX" payouts times wager to be awarded in the forms of either coins or tokens upon a win [0021] and also payouts in the form of cashless gaming with information printed on paper tickets [0022]).

Gauselmann is silent on a bonus game triggering criteria {which corresponds to player data associated with the player and player data} wherein the selected criteria is based at least partially on multiple selected outcomes of the base game and is specific to a particular player playing the base game {specific player data} and wherein upon play of the bonus game, detecting via a processor the selected triggering criterion; triggering the operation of a bonus game on a gaming machine being played by the player to which the detected triggering criterion is related; and displaying the selected visual activity on the bonus game display area of the gaming machine responsive to detecting the selected triggering criterion.

Vancura teaches of a system and method for a player to customize a casino bonus game (Abstract, Col. 1 Lines 19-22 and Figs. 3 and 4) wherein a player may choose "an aspect of the bonus game (such as, one of several games or one of several

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options within a game) preferably before initiating play on the base game, during play of the base game, or at entry to bonus play" (Col. 2 Lines 57-61) by selecting "choices presented on a video touchscreen" (Col. 3 Lines 1-2) to modify the reel symbols that trigger the bonus game to reflect a pre-selection of a type of game and set of "triggering" or "qualification" symbols associated with the player choices and stored player data (Col. 3 Lines 1-26 and Col. 4 Lines 64-67) which the player is reminded of the pre-selection choices during play of the base game (Col. 3 Lines 10-13) and wherein the choices are particular to the particular player playing the base game ("The player proactively chooses as aspect of the bonus game" Col. 2 Lines 57-58); and

operating one of the gaming machines in accordance with the stored selections including detecting the selected triggering criterion (Col. 3 Lines 40-45 and Fig. 1 wherein the pre-selected SL wedges appear on the reels);

triggering the operation of a bonus game on a gaming machine being played by the player to which the detected triggering criterion is related (appearance of the pre-selected symbols "signifies entry to the bonus play" Col. 4 Lines 65-66); and

displaying the selected visual activity on the bonus game display area of the gaming machine responsive to determining via a processor one or more of the selected triggering criterion (Fig. 1 wherein the selected category, icons and menu list of choices are depicted on the screen and reels of an active game (Fig. 1 and Col. 6 Lines 30-40 reflecting the particular game and the pre-selection of elements of the bonus game Col. 3 Lines 27-52); and

awarding any item {plurality of possible items} of value earned based on the selected {plurality of} award method{s} ("By use of the terms bonus game, there is intended no limitations to any particular form of bonus award" (Col. 1 Lines 41-52)).

With regards to Claim 45, the combination of Gauselmann and Vancura present a plurality of visual activities (bonus games) and a plurality of bonus game triggering criteria such that an operator can perform the task of choosing a second bonus game triggering criteria and bonus game different from the first as claimed by Applicant.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the customized bonus game specific to a player playing a base game who has pre-selected triggering criteria according to displayed menu lists of triggering icons, and has activated the bonus game including visual activity as taught by Vancura into the player PIN, automatic accounting information of the floor controllers, and operator configuration of the game bonus event of Gauselmann in order for an operator working remotely to use the additional selection menus to further configure a bonus game according to the pre-selected criteria of the player for a bonus game which is tracked by the floor controllers during play of the base game for a particular player. Additionally, tailoring play for a particular player affords the operator the ability to make the game more enjoyable for the player as well as efficiently broadcast the selections of a currently operating and configured machine across a bank of lower performing (less popularly configured) machines ([0048]) in order to improve the appeal and profitability of the entire bank of machines.

In Reference to Claims 14 and 15

Gauselmann discloses a system substantially equivalent to Applicant's claimed invention. However, Gauselmann is silent on a triggering criterion being a plurality of triggering criteria wherein the triggering is responsive to one {all} of the criteria being fulfilled. Vancura teaches of "monetary value and/or difficulty of the bonus game" aspects are available to the player as criteria (Col. 4 Lines 15-41). This presents a plurality of criteria, e.g., :1 Response for 100x wager" and "2 Responses for 50x wager" wherein when one or both {all} Responses can be provided to fulfill one or both {all} of the requisite criteria for the triggering event. For motivation to combine see the rejection of Claim 1.

In Reference to Claim 16

Gauselmann discloses the plurality of gaming machines and all or a subset are configured by the operator at the EGM (Fig. 8 wherein "In step 84, the configuration server 60, storing the new settings, downloads the new settings to the selected EGM or to a bank of EGMs." [0054]).

In Reference to Claims 35-37

Gauselmann discloses criteria including selection of machine selection (the operator knows the specific number of all machines), visual activity (menu of games), award (paytables and payout multipliers), and items of value ((coins, tokens or paper

can be dispensed) (See rejection of Claim 1 and 34). Vancura teaches of trigger criteria (For motivation to combine see rejection of Claims 1 and 34).

13. Claims 2-13, 30-33, 40, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gauselmann, Vancura and further in view of U.S. Patent No. 6,257,981 to Acres et al. (Acres '981) of record.

In Reference to Claims 2, 40, 47

Gauselmann as modified by Vancura discloses a system substantially equivalent to Applicant's claimed invention wherein Gauselmann also discloses identifying the player via the player's "personal identification number (PIN)" upon input of the PIN into the gaming machine ([0023]) and Vancura teaches that the reel symbols {constituting a compiled outcome displayed for the player} that trigger the bonus game are modified to reflect a pre-selection of a type of game and set of "triggering" or "qualification" symbols (Col. 3 Lines 1-26 and Col. 4 Lines 64-67) in which the player is reminded of the pre-selection choices during play of the base game (Col. 3 Lines 10-13). Thus, when the triggering symbols match the compiled outcome on the reels, the bonus game is triggered. In its broadest reasonable sense, play then is tracked as claimed by Applicant because the game has to remember each reel outcome over multiple games which are subject to the pre-selection criteria to know when to fire the trigger. If Applicant does not agree with Examiner's broad interpretation then Acres '981 teaches of robust player tracking as known in the art.

Acres '981 teaches of a computer network for controlling and monitoring gaming devices (Title) to include a "Player Tracking Module" (Col. 11 Lines 15-28) wherein "The system also allows for improved player tracking by recording each and every machine transaction including time of play, machine number, duration of play, coins in, coins out, hand paid jackpots and games played. The player tracking is conducted over the same network as the accounting data is extracted. This allows the invention to provide bonusing to certain individual players as well as during certain times. As with standard player tracking, the above-described system monitors and reports how many coins are played by each player. The system according to the invention, however, also includes the ability to record how long each player spends at each machine and the number of coins won, games played, and hand jackpots won by each player. The invention is able to record all this information because the system operates on a transaction by transaction basis." (Col. 3 Lines 20-35). Acres '981 provides this system and method in order to "provide bonusing to certain individual players as well as during certain times" (Col. 3 Lines 25-28) and affords the ability to record each and every machine transaction (Col. 3 Lines 49-50) especially in the case wherein triggering events have occurred, for example, in a bonus period (Col. 35 Lines 22-29) to control the profitability of the bonusing system (Col. 36 Lines 37-38).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the player tracking on a transaction by transaction basis and event triggering as taught by Acres '981 into the teachings of Gauselmann as modified by Vancura in order to increase the confidence of the system operators that

the configuration changes implemented are working properly by providing feedback of system performance based on actual performance data and to ensure the profitability of the bonusing system.

In Reference to Claims 3-4

Gauselmann as modified by Vancura discloses a system substantially equivalent to Applicant's claimed invention wherein a player tracking card and card reader are disclosed ([0022]) which implicitly teaches of identifying a player, transmitting information at the gaming machine through a network (Fig. 3 and [0023]). However, Gauselmann as modified by Vancura is silent on retrieving a record from a player tracking database.

Acres '981 teaches of identifying the player, transmitting the identification data through the network and retrieving from the database a player record (Col. 26 Lines 36-67; Col. 28 Lines 24; and col. 29 Lines 12 wherein the system "is able to record all this information because it operates on a transaction by transaction basis" Col. 29 Line 8 to apprise the player of the status of the player's record (Claim 42 "creating a player account which tracks the activity of the player on the gaming devices") via a player identification card and a card reader configured to access a player account (Fig. 7 and Col. 12 Lines 1-15). For motivation to combine see the rejection of Claim 2.

In Reference to Claim 5

Gauselmann discloses manually entering a PIN into the EGM via a keypad ([0023]).

In Reference to Claims 6-13

Gauselmann as modified by Vancura discloses a system substantially equivalent to Applicant's claimed invention. However, Gauselmann as modified by Vancura is silent on a set of game outcomes; consecutive game outcomes; X outcomes in N tries; a set of game outcomes within a set period of time; a certain number of points earned by the player; a number of wins/loses over a set time period; visitation frequency; and player demographics.

Acres '981 teaches of triggering events (Col. 35 Lines 22-29) based upon game outcomes (Col. 26 Lines 5-9); X outcomes in N tries (Col. 28 Lines 18-21); and a set of game outcomes within a set period of time (Col. 26 Lines 7-8). For motivation to combine see the rejection of Claim 1.

The combination of Gauselmann, Vancura, and Acres '981 is silent on criteria based on consecutive game outcomes; a certain number of points earned by the player; a number of wins/loses over a set time period; visitation frequency; and player demographics. However, Examiner takes Official Notice of the fact that these and combinations thereof are known thresholds in the gaming art related to encouraging longer and more frequent game play which translates into increased profits by the casino organization ("Multiple aspects are provided to give the player pre-selection of the nature of the bonus play upon entry into the bonus game" Col. 4 Lines 42-44). Acres '981 teaches of known and flexible criteria wherein the system "provides bonusing to certain individual players as well as during certain times" Col. 3 Lines 25-27

to include measurement of "how long each player spends on each machine and the number of coins won, games played, and hand jackpots won by each player" Col. 3 Lines 30-35 and further that the "player maybe required to play a certain number of coins before being awarded any points" Col. 22 Lines 44-46. Further, U.S. Patent No. 6,361,441 to Walker (Walker '441) of record discloses a bonus trigger event involving X outcome out of N tries as well as a number of wins/losses over a set period of time (Col. 3 Lines 4-16); U.S. Patent No. 6,503,146 to Walker (Walker '146) of record discloses obtaining bonus eligibility status upon a visitation frequency requirement (Col. 6 Lines 44-54); and U.S. Patent Pub. No. 2001/0034643 to Acres (Acres '643) of record discloses triggering criteria based on player demographics ([0018]).

Alternatively, Gauselmann as modified by Vancura and Acres '981 discloses the claimed invention except for criteria based on consecutive game outcomes; a certain number of points earned by the player; a number of wins/loses over a set time period; visitation frequency; player demographics; and a criterion which includes a plurality of triggering criteria. It would have been an obvious matter of design choice to base triggering on these criteria, since Applicant has not disclosed that anyone of these criterion solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the criterion of Acres '981 and obvious permutations stemming from the player tracking source data. Further, Acres '981 teaches "According to the invention, there are many different reconfiguration commands to implement a multiplicity of different bonusing events." (Col. 35 Lines 53-55).

In Reference to Claims 30-33

Gauselmann as modified by Vancura discloses a system substantially equivalent to Applicant's claimed invention. However, Gauselmann as modified by Vancura is silent on an award method that a random number be chosen upon a probability table designating the award in the bonus game and wherein the item of value is awarded over a series that add up to a total value.

Acres '981 teaches of additional bonus payouts that are on bonus payout schedules {probability tables} different from the regulated base game schedules (Col. 6 Lines 35-47) and of progressive jackpots wherein the value is awarded over a series of sessions that add up to a total value (Col. 6 Lines 60-63) wherein a bonus type is selected (Table 2) and on a random basis ("the bonus time promotion can be activated on a random basis" (Col. 25 Lines 58-59) to award a bonus during the bonus time promotion period (Col. 26 Lines 1-25) according to the bonus time promotion payout schedule based on "whichever bonus amount is specified by the bonus amount subfield" (Col. 26 Lines 19-22). Acres '981 also discloses an additional criterion of awarding points to players who use their tracking cards during game play in order to serve as "an additional inducement to encourage play" (Col. 28 Lines 1-9).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ award method and points criterion as taught by Acres '981 into the teachings of Gauselmann as modified by Vancura in order to have a system which provides several bonus promotions that can operate simultaneously (Col. 3 Lines 47-48) and to encourage play (Col. 28 Lines 1-9).

7. Claims 18-24, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gauselmann and Vancura and further in view of U.S. Patent No. 6,347,996 to Gilmore et al. (Gilmore) of record.

In Reference to Claims 18-24 and 28

Gauselmann as modified by Vancura discloses a system substantially equivalent to Applicant's claimed invention. However, Gauselmann as modified by Vancura is silent on the visual activity comprising a single animation sequence to be displayed on the gaming machine after which a bonus amount is awarded to the player; designating that the player be required to interact with the gaming machine in order to start or stop the animation sequence; the selected visual activity comprising a series of animations to be displayed on the gaming machine after which a bonus amount is awarded to the player; designating that the player be required to interact with the gaming machine between each animation in the series; designating that X number of possible selection areas be displayed to the player and requiring the player to pick N items; designating that X number of possible selection areas be displayed to the player and requiring the player to pick N items or until a stop is chosen which comes earlier; and the selected visual activity designating that X number of possible selection areas be displayed to the player and requiring the player to pick selection areas to review items associated with respective selection areas until a match occurs.

Gilmore teaches of a single animation sequence to be displayed on the gaming machine after which a bonus amount is awarded to the player (Fig. 4 pop-up window wherein selecting a wagon reveals a bonus (Col. 3 Lines 66-67 and Col. 4 Lines 1-5)

and designating that the player be required to interact with the gaming machine in order to start or stop the animation sequence (the pop-up is stopped after the player makes a selection (Col. 4 Lines 1-5); the selected visual activity comprising a series of animations to be displayed on the gaming machine after which a bonus amount is awarded to the player (Fig. 5 showing 20 tiles wherein after play a bonus or nominal award is provided to the player (Col. 4 Lines 10-28 and Col. 4 Lines 45-52) and designating that the player be required to interact with the gaming machine between each animation in the series (for each selection an animation occurs and reveals a match or Wild symbol, if the player does not make a choice in time one is made automatically (Col. 24-44) and designating that X number of possible selection areas be displayed to the player and requiring the player to pick N items (player selects from a matrix of 20 tiles of Fig. 5 and tries to make as many as 5 selections (Col. 4 Lines 54-66) or designating that X number of possible selection areas be displayed to the player and requiring the player to pick N items or until a stop is chosen which comes earlier (a stop occurs when 3 out of 4 Bandits are revealed (Col. 4 Lines 45-52); and the selected visual activity designating that X number of possible selection areas be displayed to the player and requiring the player to pick selection areas to review items associated with respective selection areas until a match occurs (player reviews the results of each selection and then chooses again after consideration of the remaining tiles and further to consider an image of a mining map that is incrementally being revealed with each match (Col.. 4 Lines 45-66).

It would have been obvious to one of ordinary skill in the art at the time the

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invention was made to employ the pop-up and match game as taught by Gilmore into the teachings of Gauselmann as modified by Vancura in order to produce new types of games or enhancements to existing games which will attract frequent play by enhancing the entertainment value and excitement associated with the game (Col. 1 Lines 23-28). In this case, one of the "X" games of Gauselmann could reasonably be a known match game e.g., CONCENTRATION but able to be enhanced by one of ordinary skill in the art since all of the claimed elements were known in the art at the time of the invention and one of ordinary skill could have combined said elements using known methods with no change in their respective functions in order to yield predictable results.

14. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gauselmann, Vancura, and further in view of U.S. Patent No. 6,231,445 to Acres (Acres '445) of record.

Gauselmann as modified by Vancura discloses a system substantially equivalent to Applicant's claimed invention. However, Gauselmann as modified by Vancura is silent on the bonus amount associated with the match being decremented as the number of attempts to make a match increases.

Acres '445 teaches of a variable bonus game {visual activity} (Title) wherein a series of animations (Fig. 1 spinning reels generated by animation computer 40 (Col. 4 Line 67 and Col. 5 Lines 1-10)) on slot machine 10 (Col. 4 Line 25) wherein a player interacts with the slot machine with each pull thus triggering a bonus period (Col. 6 Lines 15-24) wherein the player picks one of possible X of N paylines (Col. 5 Line 67

and Col. 6 Lines 1-5) and then tries to match symbols (such as BAR-BAR-BAR Col. 6 Line 4) to receive a bonus award. While this is occurring, the bonus amount associated with the match being decremented as the number of attempts to make a match increases ("In a preferred embodiment, the initial bonus amount is decremented over the bonus period so that the bonus amount won is greater if the winning combination occurs at the beginning of the bonus period as opposed to near the end." (Col. 2 Lines 15-32)) wherein in one embodiment, an animated balloon drifts across the screen displaying the decremented amount (Fig. 4 "200" to "100" to "15" as the passes from point 76 to 80). Acres '445 teaches that "The advantage of this concept is that it gives players the opportunity to hit large jackpots from the base progressive more frequently, by awarding more common reel combinations during specific times. It also precipitates a sense of urgency, since the smaller jackpots begin decrementing immediately, resulting in faster play." (Col. 33-38).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the decrementing bonus feature as taught by Acres '445 into the teachings of Gauselmann as modified by Vancura in order to create a sense of urgency, since the smaller jackpots begin decrementing immediately, resulting in faster play.

15. Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gauselmann, Vancura, and further in view of U.S. Patent No. 6,656,046 to Yoseloff et al. (Yoseloff).

Gauselmann as modified by Vancura discloses a system substantially equivalent to Applicant's claimed invention. However, Gauselmann as modified by Vancura is silent wherein the selected visual activity designating that the player choose to take a first bonus award or risk the first bonus award for a second bonus award and wherein the first and second bonus award comprising a plurality of items chosen in a series of selection steps.

Yoseloff teaches of reconfigurable slot games (Fig. 4 and Col. 1 Lines 5-13) in which a player may play in first, second, and third segments of a game wherein the second and third segments are bonus games mapping to Applicant's first and second bonus games. Yoseloff teaches if the player chooses to participate in the next segment of the game, "the player may place the entire award as a wager in the second segment" (Col. 14 Lines 29-34). The player can take the second bonus of wager it all in a third bonus segment ("An aspect of the present invention contemplates a mandatory second wager requirement to participate in the second segment of the game, the second wager being required to come from at least a portion of an award from a preceding segment and payout from a preceding segment (or in the case of the play of a third segment, from the earlier played first and second segment)" (Col. 13 Lines 42-53). Yoseloff also teaches of providing a plurality of awards at the conclusion of the gaming segments ("An award may include the payout, but may also include potentially non-monetary elements such as the right to proceed to another segment a display of entertainment value such as playing a film clip from a movie, or the accumulation of credits towards play in a special segment for a jackpot or progressive jackpot (Col. 14 Lines 66-67 and

Col. 15 Lines 1-5). Yoseloff provides this system and method in order to "maintain or increase player interest in wagering via changes in the visual and audio aspects of the wagering game" (Col. 7 Lines 48-50).

Gauselmann discloses selecting at the configuration workstation at least one of a plurality of special features and {plurality of} award methods that define a bonus game outcome (Gauselmann discloses special features of the selecting the reels, paylines and multiplier values of the award in Fig. 6 and selection among "paytables" [0042]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the bonus award risk and plurality of award items for each bonus award as taught by Yoseloff into the teachings of Gauselmann as modified by Vancura to be designated in a list or menu and for the operator to make a series of selections in order to maintain or increase player interest in wagering via changes in the visual and audio aspects of the wagering game.

#### ***Response to Arguments***

16. Applicant's arguments have been previously considered and remain not persuasive. Applicant argues (see Applicant's Arguments/Remarks pages 14-15) that an initial configuration "must be completed by a casino attendant at the gaming machine" and "Thereafter, the casino attendant uses the operator interfaces ...". Examiner respectfully disagrees and has directed Applicant in the past to Gauselmann ([0006, 0032, 0045]) wherein "All the initial settings may, instead, be directly defined via an operator's console without the operator being physically present at any EGM."

[0006]). Further, para. [0045] explicitly recites that this as an alternative to carry out steps 61-64 of Fig. 4. Given that this explicit recitation directly contradicts a basic premise of Applicant's core argument and has been presented in the past (Non-Final Rejection dated 04/28/2011 page 24) and remains uncorrected in the present arguments, Examiner deems Applicant's arguments unpersuasive.

17. Applicant argues (see Applicant Arguments/Remarks pages 15-16) that the Examiner is picking and choosing various elements and using improper hindsight by ignoring how the elements would interact if combined. Examiner respectfully disagrees. It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In so doing, Examiner has reviewed the teachings from the prior art and provided as part of the rejection of the claims how one of ordinary skill in the art would achieve the predictable result of allowing an operator to configure a gaming machine as a player would along with a motivation to combine the references derived independent of applicant's disclosure.

18. Applicant argues (see Applicant Arguments/Remarks page 16) that the teachings of Vancura teach away from defining initial settings via an operator's console. Examiner respectfully disagrees. A prior art's reference must be considered in its entirety, i.e.; as a whole, including portions that would leadaway from the claimed invention. W.L. Gore

& associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). However, "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed .... "*In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). Here, the disclosed ability for a player to modify a gaming machine in no way criticizes, discredits, or otherwise discourages other means to configure gaming machines such as remotely by an establishment operator.

19. Applicant argues the references individually (see Applicant Arguments/Remarks pages 16-19 and repeated for pages 20-39) and apparently without change from the previous Office Action. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Further, Applicant has not specifically addressed why the combination of references would not have been obvious to one skilled in the art. Conversely, Examiner has provided specific citations to the references and a reasoned motivation to combine the references as provided in the rejection of the claims. Thus, the rejection of the claims is maintained.

### ***Conclusion***

20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

21. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. D'Agostino whose telephone number is (571)270-1992. The examiner can normally be reached on Monday - Friday, 7:30 a.m. - 5:00 p.m..

22. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul A. D'Agostino/  
Primary Examiner, Art Unit 3716